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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,638	07/15/2003	Toru Wada	2356/12	5667

7590 12/14/2005

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EXAMINER

JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/618,638	WADA ET AL.	
	Examiner	Art Unit	
	Monique R. Jackson	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 9/29/05 has been entered. Claims 1-20 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Terminal Disclaimer

3. The terminal disclaimer filed on 9/29/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issuing from Application 10/279,005 has been reviewed and is NOT accepted.

- a. The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.
4. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

Claim Rejections - 35 USC § 102

5. Claims 1, 2, 4, 7-9, 11, 12 and 19 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by EP 1 306 725 A1 or Wada et al (US 2003/0082482 A1), respectively. Wada et al teach a photosensitive resin laminate and a method for forming a mask on the photosensitive laminate by IR ablation as instantly claimed wherein the laminate comprises a support, a photosensitive layer and an IR ablation layer wherein the IR ablation layer comprises an IR absorbent metal deposition layer and IR non-sensitive polymer resin layer laminated on said metal layer (Abstract; Claims 4 and 5; Paragraphs 0007-0024, 0086-0087, 0092-0094;

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Examples.) Wada et al teach that the photosensitive layer comprises a thermosetting or alkyd resin wherein after IR ablation, the non-polymerized part of the photosensitive layer and the IR ablation layer are removed and hence the Examiner takes the position that the photosensitive layer reads upon the limitation “a release layer” between the substrate and the IR ablation layer” (Paragraphs 0058-0059 and 0095.) Wada et al further teach that the laminate may comprise a release layer between a cover film and an IR ablation layer wherein a cover film may be on the photosensitive laminate to protect the IR ablation layer during storage and handling and removed before or after IR irradiation (Paragraphs 0069 and 0073.)

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Zoeren (USPN 5,506,086) for the reasons recited in the prior office action wherein the Examiner notes that Van Zoeren specifically teaches that metallic materials for use as the IR ablatable layer may be applied with or without a binder (Col. 5, lines 26-27.) Van Zoeren teaches a process for making a flexographic printing plate from a photosensitive laminate by forming a mask via IR ablation wherein the laminate comprises a support and an IR ablatable layer wherein the IR ablatable layer may be applied by vapor deposition or sputtering, particularly in the case of metal layers (Abstract; Col. 5, lines 25-27; Col. 10, lines 43-63; Col. 14, lines 14-15.) Hence, Van Zoeren clearly teaches an IR ablatable or sensitive layer consisting of an IR absorbent metal.

Claim Rejections - 35 USC § 103

8. Claims 3, 5, 6, 10, 13-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada et al in view of Takeda et al (USPN 5,858,604.) The teachings of Wada et al are discussed above. Wada et al do not teach the use of an anti-blocking layer as instantly claimed on the back side of the support from the IR ablation layer however Takeda et al teach a similar photosensitive laminate wherein anti-blocking properties may be provided in a light shielding layer or plural layers and wherein the laminate may be provided with a backing layer to provide transporting stability and anti-abrasion properties which would read upon the instantly claimed anti-blocking layer. Hence, one having ordinary skill in the art at the time of the invention would have been motivated to provide an anti-blocking backing layer as taught by Takeda et al to provide anti-blocking properties and transporting stability of the laminate taught by Wada et al. Further, one having ordinary skill in the art at the time of the invention would have been motivated to determine the desired combination of layers taught by Wada et al for a particular end use and to utilize the resin materials taught by Wada et al, such as thermosetting or alkyd resins or other suitable resin material, in the additional layers taught by Wada et al.

Double Patenting

9. Claims 1, 2, 11 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4, 5, 10, 11, 13-15, and 17 of copending Application No. 10/279,005. The co-pending application claims a photosensitive laminate comprising a support, a photosensitive layer, an IR ablation layer comprising an IR absorbent metal deposition layer and a non-IR sensitive polymer layer and hence fully encompass the cited claims of the instant application.

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This is a provisional obviousness-type double patenting rejection.

Response to Arguments

10. Applicant's arguments filed 9/29/05 have been fully considered but they are not persuasive. First, with regards to the Applicant's claim to the earlier foreign priority date, as stated above, the foreign priority has not been perfected because the foreign application was not in English and a translation of said papers has not been made of record. In terms of Van Zoeren, as discussed above, Van Zoeren clearly teaches that the IR sensitive layer may be a vapor deposited metal layer wherein when metallic materials are utilized, they may be applied without a binder. Lastly, in terms of the obviousness double patenting rejection, the terminal disclaimer filed on 9/29/05 does not overcome the rejection considering the terminal disclaimer was not accepted.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508.

The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson
Primary Examiner
Technology Center 1700
December 12, 2005